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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/804,947 | 03/18/2004 | John Kenneth Goldermann Thuneby | M61.12-0570 | 9175 |
| 27366 7590 04/24/2009 WESTMAN CHAMPLIN (MICROSOFT CORPORATION) SUITE 1400 900 SECOND AVENUE SOUTH MINNEAPOLIS, MN 55402 | | | | |
| | | | EXAMINER HAMMOND III, THOMAS M | |
| | | | ART UNIT 3695 | PAPER NUMBER |
| | | | MAIL DATE 04/24/2009 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/804,947

Applicant(s)

THUNEBY ET AL.

Examiner

THOMAS M. HAMMOND III

Art Unit

3695

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9-12 and 14-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the Applicant's response filed on 10 February 2009.
2. Claims 5-8 and 13 have been cancelled.
3. Claims 17-21 have been newly added.
4. Claims 1 and 9 have been amended.
5. Claims 1-4, 9-12 and 14-21 are currently pending and have been examined.

Response to Arguments

6. The Applicant's arguments are considered moot in view of the new grounds of rejection presented below, necessitated by the Applicant's substantial amendments to the claimed invention.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-4, 9-12 and 14-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. Regarding claims 1-4, 9-12 and 14-21, it appears that the Applicant is attempting to claim both a system and a method in the same embodiment. However, a system must clearly disclose the physical components of such system in order to be eligible for patentability. Likewise, a method must properly tie each substantial step of the method to its respective machine that is performing said step. In the instant application, the Applicant has accomplished neither the system or method requirements for patentability. Appropriate action is required.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1-4, 9-12 and 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al., US Patent No. 6,067,551, in view of Land et al., US Patent No. 6,807,533, in further view of, Kaplan et al., US Patent No. 6,584,453.

As per claim 1***Brown teaches:***

- Generating a new document that is a copy of the original document in response to a command to edit the original document (see at least column 12, lines 17-24)
- Modifying at least one of the data elements in the new document (see at least column 12, line 26 – column 14, line 40)
- Saving the modified new document in the computer storage medium (see at least column 12, line 26 – column 14, line 40)
- Nullifying the original document by posting the modified new document as a new original document (see at least column 12, line 26 – column 14, line 40)
- Posting data elements of the modified new document in the original document to create a new original document (see at least column 12, line 26 – column 14, line 40)

Brown does not teach:

- Wherein the document is a transaction document consisting of an invoice or a vendor bill
- Wherein the transactions in the transaction document consists of a product sale, a credit to an account or a debit to an account

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- Nullifying an original transaction posting in a general ledger by posting a cancelling transaction in the general ledger
- Posting an adjusting transaction to the general ledger

Land teaches:

- Wherein the document is a transaction document consisting of an invoice or a vendor bill (see at least column 6, lines 6-41)
- Wherein the transactions in the transaction document consists of a product sale, a credit to an account or a debit to an account (see at least column 6, lines 6-41)

Kaplan teaches:

- Nullifying an original transaction posting in a general ledger by posting a cancelling transaction in the general ledger (see at least column 5, line 30 – column 6, line 38)
- Posting an adjusting transaction to the general ledger (see at least column 5, line 30 – column 6, line 38)

However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the features of Land and Kaplan to the teachings of Brown. One would have been motivated to do so to help facilitate account balancing at the appropriate time (see at least Land column 3, lines 9-17). Furthermore, as evidenced by the prior art, each functional element of the claimed invention is old and well known in the accounting and data processing arts. It appears that the Applicant has merely combined these well known elements to perform their same functions into one product. However, merely combining well known elements with predictable results does not render an invention patentably distinct over the combination of such elements. Moreover, the Applicant has not provided any evidence or suggestion that such prior art elements perform differently in combination. As such, one of ordinary skill in the art would conclude that the combination of the prior art elements of Brown, Land and Kaplan, renders the instant invention obvious.

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As per claim 2

Brown, in view of Land and Kaplan, teaches the method of claim 1, as described above.

Brown further teaches:

- Wherein the modifying step includes adding, deleting, or changing a data element in the new document (see at least column 12, line 26 – column 14, line 40)

As per claim 3

Brown, in view of Land and Kaplan, teaches the method of claim 2, as described above.

Land further teaches:

- Wherein the modifying step includes applying a credit, applying a debit, modifying a quantity, or modifying a cost of the new transaction document (see at least column 10, lines 25-41)

As per claims 4 and 6-7

Brown, in view of Land and Kaplan, teaches the method of claim 2, as described above.

Kaplan further teaches:

- Wherein the posting step is performed in response to the saving step (see at least column 6, lines 20-31)

As per claims 9-12 and 14-21

Claims 9-12 and 14-21, as best understood by the Examiner, are interpreted to encompass the same or substantially the same scope as claims 1-4. Accordingly, claims 9-12 and 14-21 are rejected in the same or substantially the same manner as claims 1-4.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Hammond III whose telephone number is 571-270-1829. The examiner can normally be reached on Monday - Friday, 7AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas M Hammond III
Patent Examiner, Art Unit 3695
US Patent & Trademark Office
17 April 2009

/Thu Thao Havan/
Primary Examiner, Art Unit 3695